



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,459	01/15/2004	Thomas Lummis	40661-031	5873
29493 7590 02/14/2008 HUSCH & EPPENBERGER, LLC 190 CARONDELET PLAZA SUITE 600 ST. LOUIS, MO 63105-3441				
EXAMINER				
MAL, TRI M				
ART UNIT		PAPER NUMBER		
3781				
MAIL DATE		DELIVERY MODE		
02/14/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/758,459

Applicant(s)

LUMMIS ET AL.

Examiner

Tri M. Mai

Art Unit

3781

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF 298)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

1. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to the optimizing relocation of forces, Applicant's assertion that having only one support as compared having multiple support location would enhance the cover's ability to withstand peak wind condition contradicts physic laws as set forth in the previous Office Action.

2. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Porter (5904243), or in the alternative, under 35 U.S.C. 103(a) as being unpatentable over Porter in view of Frieder et al. (3011820). Porter teaches a the securing of a cover comprising the steps of placing the cover over the module and threading a securing strap through a channel in the cover and tightening the securing strap about the module as claimed. Porter meets all claimed limitations except for the limitation of having no more than one point of contact between the securing strap and support straps. It would have been obvious to one of ordinary skill in the art to provide only one support to provide the desired number of support and/or to save material. Furthermore, it would have been obvious to one of ordinary skill in this art to eliminate the other when its function is not desired. See, Ex parte Rainu, 168 USPQ 375 (PTO Bd. Of App. 1969).

In the alternative, Frieder teaches that it is known in the art to provide the sides with only one support (note figures 1, and 4). It would have been obvious to one of ordinary skill in the art to provide only one support, as taught by Frieder, to provide the desired number of support and/or to save material.

3. Claim 1-3, 5, 6, 9-11, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Porter rejection, as set forth above, and further in view of either Horwath

(2003/0226846) or Gallagher (4308905). It would have been obvious to one of ordinary skill in the art to provide another channel on the other end wall to provide added security. Furthermore, it would have been obvious to a person having ordinary skill in the art to duplicate parts for a multiplied effect (St. Regis Paper Co. v. Bemis Co., Inc.)193 USPQ 8, 11 (7th Cir. 1977).

With respect to support strap at the midpoint, to have the only one support strap in the modified cover of Porter to be placed at the midpoint at the corresponding side walls would have been obvious to provide the desired placement of the support strap. Furthermore, Rearrange parts of an invention involves only routine skill in the art, see In Re Japikse, 86 USPQ 70 (CCPA) 1950.

Regarding claim 2, with respect of threading the strap through the first and second support straps, it would have been obvious to one of ordinary skill in the art to eliminate the rings so that the strap are threaded through the first and second support straps to save material. Note that it is within the skill of one of ordinary skill in this art to eliminate the other when its function is not desired. See, Ex parte Rainu, 168 USPQ 375 (PTO Bd. Of App. 1969). There are two triangular sections in each of sidewalls as claimed. It is noted that the term section is broad, there are a plurality of section in the cover of Porter, include a triangular section as claimed.

To the degree it is argued that the cover of Porter does not teach the triangular sections, it would have been obvious to one of ordinary skill in the art to make the cover from various sections including triangular sections because construction of a product in unity or diversity would have been an obvious choice of manufacturing or convenience. See, In re Zabel et al. 38 C.C.P.A., 832, 186 F.2d 735, 88 USPQ 367.

4. Claims 4, 7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Porter rejection as set forth in paragraph 4, and further in view of either Campbell (2705461) or Frieder et al. (3011820). It would have been obvious to one of ordinary skill in the art to provide diamond shaped loops, as taught by either Campbell or Frieder to provide an alternative shape loop.
5. Applicant's arguments along with the Declaration under 37CFR 1.132 have been fully considered but they are not persuasive. Applicant asserts that there was empirical testing compared to Porter products. It is noted that applicant's testimony can not take place of evidence, and there is no evidence in this case showing the device with only one point of contact would perform better than the device as applied by Porter. Furthermore, it is noted of the following sections under MPEP 716.02(a).

Applicants must further show that the results were greater than those which would have been expected from the prior art to an unobvious extent, and that the results are of a significant, practical advantage.
Ex parte The NutraSweet Co., 19 USPQ2d 1586 (Bd. Pat. App. & Inter. 1991)

716.02(b) [R-2] Burden on Applicant

>I. < BURDEN ON APPLICANT TO ESTABLISH RESULTS ARE UNEXPECTED AND SIGNIFICANT

The evidence relied *upon< should establish "that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance." Ex parte Gelles, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992) (Mere conclusions in appellants' brief that the claimed polymer had an unexpectedly increased impact strength "are not entitled to the weight of conclusions accompanying the evidence, either in the specification or in a declaration."); Ex parte C, 27 USPQ2d 1492 (Bd. Pat. App. & Inter. 1992)

>II. < APPLICANTS HAVE BURDEN OF EXPLAINING PROFFERED DATA

"[A]ppellants have the burden of explaining the data in any declaration they proffer as evidence of non-obviousness." Ex parte Ishizaka, 24 USPQ2d 1621, 1624 (Bd. Pat. App. & Inter. 1992).

>III. < DIRECT AND INDIRECT COMPARATIVE TESTS ARE PROBATIVE OF NONOBVIOUSNESS

Evidence of unexpected properties may be in the form of a direct or indirect comparison of the claimed invention with the closest prior art which is commensurate in scope with the claims. See In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) and MPEP § 716.02(d) - § 716.02(e). See In re Blondel, 499 F.2d 1311,

Art Unit: 3781

1317, 182 USPQ 294, 298 (CCPA 1974) and *In re Fouche*, 439 F.2d 1237, 1241-42, 169 USPQ 429, 433 (CCPA 1971) for examples of cases where indirect comparative testing was found sufficient to rebut a prima facie case of obviousness. The patentability of an intermediate may be established by unexpected properties of an end product "when one of ordinary skill in the art would reasonably ascribe to a claimed intermediate the contributing cause" for such an unexpectedly superior activity or property." *In re Magerlein*, 602 F.2d 366, 373, 202 USPQ 473, 479 (CCPA 1979). "In order to establish that the claimed intermediate is a contributing cause" of the unexpectedly superior activity or property of an end product, an applicant must identify the cause of the unexpectedly superior activity or property (compared to the prior art) in the end product and establish a nexus for that cause between the intermediate and the end product." *Id.* at 479.

716.02(e) [R-2] Comparison With Closest Prior Art

An affidavit or declaration under 37 CFR 1.132 must compare the claimed subject matter with the closest prior art to be effective to rebut a prima facie case of obviousness. *In re Burckel*, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979). "A comparison of the claimed invention with the disclosure of each cited reference to determine the number of claim limitations in common with each reference, bearing in mind the relative importance of particular limitations, will usually yield the closest single prior art reference." *In re Merchant*, 575 F.2d 865, 868, 197 USPQ 785, 787 (CCPA 1978) (emphasis in original). Where the comparison is not identical with the reference disclosure, deviations therefrom should be explained, *In re Finley*, 174 F.2d 130, 81 USPQ 383 (CCPA 1949), and if not explained should be noted and evaluated, and if significant, explanation should be required. *In re Armstrong*, 280 F.2d 132, 126 USPQ 281 (CCPA 1960) (deviations from example were inconsequential).

Applicant is noted that applicants have the burden of establish results that are unexpected and significant. Furthermore, it is noted that applicants have burden of explaining proffered data and to file an affidavit or declaration under 37 CFR 1.132 to compare the claimed subject matter with the closest prior art to be effective to rebut a prima facie case of obviousness.

Furthermore, in this case, applicant seems to assert superiority over the Porter cover base on the use of single point support. This particularity must be tested and data must be explained so that it is the placement of the single point support is the nexus of the superiority of the cover, and not of other structural changes.

With respect to the assertion to the commercial success, the examiner submits that applicant has not established a nexus between claimed invention and evidence of commercial success is required.

6. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (571)272-4541. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on (571)272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tri M. Mai/
Primary Examiner, Art Unit 3781